

Remarks

The Rejection of Claims 23-30 Under 35 U.S.C. §112

The Examiner rejected Claims 23-30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner indicated that the above-identified claims lacked proper antecedent basis and/or improperly depended from Claims 20.

Applicant has amended the claims as suggested by the Examiner to include the proper antecedent basis. Applicant respectfully submits that the amendments overcome the rejection under 35 U.S.C. §112, and reconsideration of the rejection is courteously requested.

The Rejection of Claims 18-24 and 31-35 under 35 U.S.C. §103(a)

The Examiner rejected Claims 18-24 and 31-35 under 35 U.S.C. §102(b) as being obvious to one having ordinary skill in the art at the time the invention was made in view of the teachings of U.S. Patent Nos. 1,588,332 (Peters), 3,478,482 (Weir), 5,186,883 (Beall III and 6,085,476 (Jantzi et al.). More specifically, the Examiner rejected Claims 18-21 and 23-24 under 35 U.S.C. §103 as being obvious in view of Peters, Weir and Beall, III and Claims 22 and 31-35 were rejected under 35 U.S.C. §103 as being obvious in view of Jantzi et al., Peters, Weir, and Beall, III. Applicant respectfully traverses the rejections.

"Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed

element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Hence, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 16 USPQ2d 1430. In the present case none of the references cited contain a suggestion or motivation to combine the references as suggested by the Examiner.

More specifically, with regard to the rejection of Claims 18-21 and 23 and 24, Claim 18 of the present application for patent includes the limitation that the building block of the present invention includes a laterally disposed first channel proximate an interior surface of the building block for securing a sealing means and a laterally disposed second channel proximate the exterior surface of the building block that is configured for passing utility lines, wires, etc, therethrough. Claim 18 further includes the limitation that first channel is smaller than the second channel.

In the present case, none of the references cited by the Examiner contain a teaching, suggestion or motivation to make the combination propounded by the Examiner. Simply put,

there is no teaching, suggestion or motivation to create a combination building block comprising a first smaller sealing channel disposed proximate an exterior surface of the building block and a second larger utility channel disposed proximate an interior surface for passing utility lines therethrough.

As the Examiner correctly notes, Peters does not disclose, teach or suggest first and second grooves proximate the interior and exterior building block surfaces and does not disclose, teach or suggest that the first and second channels are of different size.

Weir does not disclose, teach or suggest a first and second channels disposed proximate interior and exterior building block surfaces wherein the first channel is smaller than the second channel. Rather, Weir discloses a standard rectangular modular block having a tapered hollow truncated pyramid shaped hole of square transverse section (See Col. 1, Lines 14-18) comprising a groove that extends completely around the outer face of the block. Weir does not teach two channels and does not even suggest the desirability of two channels.

Finally, Beall III does not disclose, teach or suggest a first and second channels disposed proximate interior and exterior building block surfaces wherein the first channel is smaller than the second channel. Rather Beall III merely discloses a method of forming a concrete block wherein a concrete block comprising a utility channel, "is used only on blocks which are used as the bottom level for any particular story of construction just above floor level." Beall III does not suggest two channels much less two differently sized channels disposed on interior and exterior surfaces of a building block.

Consequently, in view of the fact that none of the references contain sufficient teaching, suggestion, or motivation to make the combination propounded by the Examiner, Applicant respectfully submits that Claim 18, and those claims depending therefrom, are nonobvious in view of the cited references.

Applicant addresses the rejection of Claims 23 and 24 herebelow as such claims now depend from Claim 22.

With regard to the rejection of Claims 22 and 31-35 in view of Peters, Weir, Beall III and Jantzi et al., Applicant respectfully submits that none of the references cited by the Examiner contain sufficient teaching, suggestion or motivation to combine the references to make the combination propounded by the Examiner, that the Jantzi et al. reference is not even remotely analogous to Applicant's invention, and even if one were to combine the references as suggested by the Examiner, the resulting invention would not even resemble Applicant's invention.

Jantzi et al. disclose a building form structure comprising extruded plastic blocks, for example polystyrene foam, configured for forming a pair of walls between which an aggregate material, such cement, sand or pebbles, may be placed to form a solid wall. Such walls are very different from Applicant's invention. The present invention comprises a modular building and blocks therefore comprising grooves, channels, vertical apertures therein for forming vertical ducts within the walls, concrete reinforcing beams, ceiling beam holder boxes, etc. Jantzi et al. do not disclose, teach, or suggest remotely similar modular building or building blocks comprising grooves, channels, vertical apertures formed in the walls by adjacent blocks, concrete reinforcing beams, ceiling beam holder boxes, etc. Consequently, given the very different nature

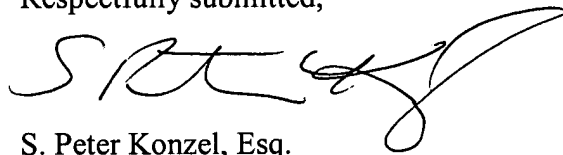
between the invention of Jantzi et al. as compared to the inventions of Peters, Weir and Beall III, there does not even exist a motivation to select the above-identified references for combination. Consequently, in view of the fact that the invention of Jantzi et al. is wholly different from that of Applicants invention and Peters, Weir and Beall III, Jantzi et al. does not disclose, teach or suggest numerous elements of Applicant's invention, and because none of the references contain a suggestion or motivation to make the combination propounded by the Examiner, Applicant respectfully submits that the invention of Claims 22, and 31-35 is nonobvious in view of Jantzi et al., Peters, Weir and Beall III.

Withdrawal of the rejection is respectfully requested.

Conclusion

For the reasons set forth above, Applicant respectfully submits that the above-identified application is now in condition for allowance, which action is courteously requested.

Respectfully submitted,



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Dated: September 12, 2003